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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,194

12/23/2005

Jurgen Stetter

710270-030

4116

7590

11/17/2006

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EXAMINER

LEE, GILBERT Y

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/562,194	Applicant(s) STETTER ET AL.	
	Examiner Gilbert Y. Lee	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/28/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 8/28/06 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the gasket element turned towards recess in claim 21 and the at least one hollow in claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "the opening" in 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12-15, 17, 18, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubouchi et al. (US Patent No. 5,544,901).

Regarding claim 12, the Kubouchi et al. reference discloses a cylinder head gasket (Fig. 8) for an internal combustion engine (Col. 1, Lines 8-12), insertable for the sealing of components having at least one T-junction (Fig. 11), said gasket having at least one function portion (e.g. 5 and 7), at least one distance portion (6), and at least one seal element (26) provided in the region of the T-junction (Fig. 8) wherein the distance portion has at least one recessed region (10) having a seal engaging bottom surface (e.g. bottom surface of element 6 in which elements 36 are in contact with), said recessed region receiving a portion of said seal element (Fig. 10).

Regarding claim 13, the Kubouchi et al. reference discloses the seal element protruding outwardly from the recessed region in the direction of at least one of the sealed components (Fig. 10).

Regarding claim 14, the Kubouchi et al. reference discloses the distance portion in the region of the seal element being associated with at least one functional portion (Fig. 10), said functional portion having an opening (e.g. 11) sized to receive said seal element therethrough in detached fashion (Fig. 10).

Regarding claim 15, the Kubouchi et al. reference discloses the recessed region having a larger surface (e.g. surface of element 6 at 10) in cross-section than said opening (Fig. 10).

Regarding claim 17, the Kubouchi et al. reference discloses the recessed region being generally oval in form (Fig. 8).

Regarding claim 18, the Kubouchi et al. reference discloses the seal element being partially supported on a boundary region of the distance portion surrounding the recessed region (Fig. 9).

Regarding claim 21, the Kubouchi et al. reference discloses a hollow channel (e.g. 11) in open communication with an opening (Fig. 8) and the seal element being partially received in said channel (Fig. 10).

Regarding claim 22, the Kubouchi et al. reference discloses the seal element comprising at least one silicone worm (Col. 6, Lines 24-27).

5. Claims 12, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Habuta et al. (US Patent No. 5,895,056).

Regarding claim 12, the Habuta et al. reference discloses a cylinder head gasket (Fig. 1) for an internal combustion engine, insertable for the sealing of components having at least one T-junction (e.g. 30), said gasket having at least one function portion (e.g. 5 and 10), at least one distance portion (6 and 15), and at least one seal element (25) provided in the region of the T-junction (Fig. 1) wherein the distance portion has at least one recessed region (e.g. 13) having a seal engaging bottom surface (e.g. bottom surface of element 15 in which elements 25 is in contact with), said recessed region receiving a portion of said seal element (Fig. 3).

Regarding claim 16, the Habuta et al. reference discloses at least a part of the recess (e.g. 11) being provided above the recessed region (Fig. 3) and being essentially parallel thereto (Fig. 3).

Regarding claim 19, the Habuta et al. reference discloses the seal element being arranged in the recessed region without contacting boundaries of the recessed region (e.g. 13) and being supported by said bottom surface of the recessed region (e.g. bottom surface of element 15 in which elements 25 is in contact with).

Response to Arguments

6. Applicant's arguments with respect to claims 12-19, 21, and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilbert Y. Lee whose telephone number is 571-272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on (571)272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3673

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GL

November 13, 2006

A handwritten signature in black ink, appearing to read 'Patricia Engle', with a stylized flourish at the end.

Patricia Engle
Supervisory Examiner
Tech. Center 3600